

REMARKS

Claims 1-40 are pending in the application. By this Amendment, claims 38-40 have been newly added. No new matter has been entered.

As an initial matter, Applicant respectfully notes that the Office Action lacks a clear indication of the status of claims 16 and 17. Although claims 16 and 17 were indicated as being rejected in the Office Action Summary, those claims were not subject to any rejections in the Office Action. Thus, Applicant presumes claims 16 and 17 should be allowable. If, however, the Examiner intended a rejection of those claims, Applicant respectfully requests that the Examiner set forth a detailed explanation of the basis for that rejection and make any subsequent Office Action non-final to provide Applicant with a full and fair opportunity to respond.

In the Office Action, claims 1-10, 12-14, 18-27, 29, and 32-36 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kim (U.S. Patent No. 4,615,635).

Applicant respectfully disagrees with this 35 U.S.C. § 102(b) rejection because Kim does not disclose each and every element of Applicant's independent claim 1. For example, Kim lacks disclosure of "at least one opening ... being configured to allow the product to be delivered outside the applicator elements at a location closer to the base than the free end," as recited in claim 1.

As best shown in Figs. 4 and 5, Kim discloses a toothbrush having a longitudinal passageway 42 for flowing toothpaste to an opening 44 within bristles 12 of a brush head. The Examiner asserted that the toothbrush of Kim includes "an opening [44] that is closer to the base of the applicator elements than to the ends thereof." Applicant respectfully disagrees with the Examiner's interpretation of Kim.

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For example, Kim at col. 5, lines 5-17, discloses that the opening 44 is located in the top of a raised portion 46 extending upwardly to a distance of about one-half the height of the bristles 12, and that by the use of the raised portion 46, toothpaste exiting from passageway 42 through opening 44 would be deposited near the upper area of the bristles 12 rather than at the bottom of the bristles 12. Consequently, Kim teaches away from a configuration where product is "delivered outside the applicator elements at a location closer to the base than the free end," as recited in claim 1.

Thus, independent claim 1 is patentably distinguishable from Kim. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Kim.

Claims 1, 2, 12, 14, 15, 18-20, 26, 27, 29, 30, 32, and 34-37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Henkel (European Patent Application Publication No. 0 276 713)¹.

Applicant respectfully disagrees with this 35 U.S.C. § 102(b) rejection because Henkel does not disclose each and every element of Applicant's independent claim 1.

Henkel discloses a device for hair dye having an adapter 3 and an application aid 2. The adapter 3 has an oblique face including an annular passage 13 that is coaxial relative to a rotational axis 12 of the application aid 2. The annular passage 13 is initially closed by a tear-off foil 14. The applicator aid 2 having bristles 22 is placed onto the oblique face of the adapter 3. In a first use of the applicator 2, after an outer cap 1 is removed, the applicator aid 2 is rotated 180° about the rotational axis 12

¹ A complete English language translation of that reference is attached to this Amendment.

perpendicular to the oblique face so as to remove the tear-off foil 14. Henkel, however, lacks disclosure of, among other things, "a movable support configured to be movable between a first position in which the at least one opening is closed off and a second position in which the at least one opening is at least partially uncovered," as recited in claim 1.

The Examiner construed the application aid 2 as corresponding to the recited "movable support" and the annular passage 13 as corresponding to the recited "at least one opening ... configured to allow the product to be delivered outside the applicator elements." The Examiner then asserted that the device of Henkel is used "by sliding the [application aid] to an open position to apply dye to the hair of a user and then closing the device." Applicant respectfully disagrees with the Examiner's interpretation of Henkel.

Contrary to Examiner's assertion that the annular passage 13 corresponds to the recited opening, the annular passage 13 is not configured to "allow [a] product to be delivered outside the applicator elements at a location closer to the base than the free end," as recited in claim 1. Instead, the annular passage 13 merely provides a passage positioned between a mouth 6 of the container 5 and a dispensing opening 20 of the application aid 2. It appears that the only element in Henkel that may arguably be construed as corresponding to the recited opening is the dispensing opening 20. However, movement of the application aid 2, which the Examiner cited for the asserted disclosure of the recited "movable support," does not cause closing and/or at least partial uncovering of the dispensing opening 20.

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For at least these reasons, independent claim 1 is patentably distinguishable from Henkel. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Henkel.

Claims 1-3, 9, 12, 14, 15, 18-21, 27, 29, 30, and 32-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Vito (U.S. Patent No. 2,897,826) in view of Donley et al. (U.S. Patent No. 4,090,522).

Applicant respectfully disagrees with this 35 U.S.C. § 103(a) rejection because the Office Action does not establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained below, the attempted combination of Di Vito and Donley et al. does not establish a *prima facie* case of obviousness under 35 § U.S.C. § 103(a).

In particular, as to the second criterion, there is no suggestion or motivation in either Di Vito and Donley et al. to combine or modify the asserted teachings of the

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references in the manner proposed in the Office Action. In the rejection statement, the Examiner asserted that it would have been obvious to one of ordinary skill in the art to provide the applicator of Di Vito with a slidable teeth unit of Donley et al. in order "to provide a closure that prevents any leaking from the container while not in use and improve the reliability and convenience of the device." Applicant respectfully disagrees with the Examiner's asserted motivation because there is no clear and particular reason why one of ordinary skill in the art would be motivated to take the asserted teachings of Donley et al. relating to a medicated comb for applying medication to the hair and scalp, and combine them with the asserted teachings of Di Vito relating to a comb having a measuring and mixing device for dyeing hair.

Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the applicator of Di Vito with a teeth unit 18 of Donley et al. because, unlike the medicine application device of Donley et al., there is no reason for modifying the hair dye applicator of Di Vito to include a movable closure for selectively stopping and starting product dispensing. A principle object of Di Vito is to enable a user to accurately prepare any given formula in the exact proportion and amount needed and to apply all of that prepared formula at once (see, e.g., col. 1, lines 22-28), whereas the medication applicator of Donley et al. is intended to be conveniently carried in a purse or pocket so that multiple application treatments may be applied over a period of time (see, e.g., col. 1, lines 10-15). Thus, providing a closure to the applicator of Di Vito would destroy the principle objective of Di Vito. Therefore, one of ordinary skill in the art would not have been motivated to modify the device of Di Vito to incorporate a closure element in the manner proposed by the Examiner.

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Furthermore, Di Vito includes an embodiment with open-tipped teeth 22, as shown in Fig. 3. Of all of the embodiments shown in the drawings of Di Vito, the embodiment of Fig. 3 is the one most similar to the applicator of Donley et al. where the medication is intended to be delivered to the tips of the teeth 22. Consequently, even if the applicator of Di Vito could somehow be modified by including the teeth unit of Donley et al., it is more than likely that the embodiment shown in Fig. 3 of Di Vito would be used, instead of Di Vito's embodiment shown in Fig. 1. In that case, the openings then would not be "configured to allow the product to be delivered outside the applicator elements at a location closer to the base than the free end." Instead, the product would be delivered to the tips of the teeth 22, which are closer to the free ends of the applicator elements.

For at least these reasons, Applicant submits that a *prima facie* case of obviousness has not been properly established and respectfully requests reconsideration and withdrawal of this ground of rejection under 35 U.S.C. § 103(a).

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim; claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel in view of Magharehi (U.S. Patent No. 5,937,866); and claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel.

Each of claims 11, 28, and 31 depends from allowable independent claim 1. Consequently, claims 11, 28, and 31 should also be allowable at least by virtue of their dependency from allowable claim 1.

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In addition, Applicant has added new claims 38-40, each of which depends from allowable independent claim 1. Consequently, these claims should also be allowable at least by virtue of their dependency from allowable claim 1.

Applicant respectfully requests the reconsideration of this application, the withdrawal of all the outstanding rejections, and the allowance of claims 1-40.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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